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| 09/965,597 | 09/26/2001 | Daniel S. Gluck | GLU-01 | 3506 |

7590 08/01/2005

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BORISSOV, IGOR N

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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,597

Applicant(s)

GLUCK ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,6,9,15,17,18,23,26,28,31,37,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,6,9,15,17,18,23,26,28,31,37,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Amendment received on 4/18/2005 is acknowledged and entered. Claims 2, 3, 5, 7, 8, 10-14, 16, 19-22, 24-25, 27, 29-30, 32-36, 38, 41-49 have been canceled. Claims 1, 6, 9, 15, 17, 18, 23, 26, 28, 31, 37, 39 and 40 have been amended. Claims 1, 4, 6, 9, 15, 17, 18, 23, 26, 28, 31, 37, 39 and 40 are currently pending in the application.

Claim Objections

Claim Objections have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 101

Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, 9, 15, 17, 18, 23, 26, 28, 31, 37, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 1 and 23, the phrase "minimally-polluting" is confusing and indefinite. The Claims do not provide any indication of range of values, which would allow to assess said terminology.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 15, 26, 28 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 6,785,592) in view of Walker et al. (US 6,466,919) and further in view of Ishimaru et al. (US 5,432,710).

Smith et al. (Smith) teaches a computer-implemented method and system for optimization of energy procurement, comprising:

Claims 1 and 23.

Collecting and storing information related to energy conservation measures, said measures including energy equipment, energy and capital improvement investments (C. 6, L. 22-30);

collecting and storing information related to energy demand for clients (C. 7, L. 19-23; C. 9, L. 30-34);

calculating and providing a proposed solution for said measures, including: optimization of equipment, costs and operations of energy systems, and replacing energy-related equipment based on the collected information (C. 12, L. 42-54; C. 20, L. 59), wherein said collected information includes: regulatory-related issues (C. 14, L. 46-50), and site related information such as climate, weather and time zone data (C. 14, L. 53-54; C. 15, L. 45-47);

negotiating for obtaining discount for energy related services, including increase the volume of energy consumed at a discount (C. 20, L. 40-41);

conducting feasibility and cost-effectiveness analysis for replacing existing equipment (C. 14, L. 17-18);

optimizing the cost of replacing energy-related equipment (C. 12, L. 42-45; C. 20, L. 59);

implementing said measures (C. 6, L. 20), thereby indicating receiving a commitment from an individual client to spend funds for said measures.

However, Smith does not explicitly teach creating a binding contract if aggregate number of customers allows to implement said volume discount. Also, Smith does not

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specifically teach that said energy equipment is minimally-polluting energy generation equipment.

Walker teaches a computer-implemented method and system for aggregating multiple buyers utilizing conditional purchase offers (CPO) for goods or services, wherein, if a seller accepts said aggregated CPO, an aggregate CPO management system binds the buyers on behalf of the accepting seller, to form one or more legally binding contracts (C. 2, L. 65 – C. 3, L. 3).

Ishimaru et al. (Ishimaru) teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith to include creating a binding contract if aggregate number of customers allows to implement said volume discount, as disclosed in Walker, because it would advantageously allow to recover financial losses if customers defaults.

And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith and Walker to include that said energy conservation measures, which include energy equipment improvement and investments, are based in part on new technology issues including non-polluting issues, as disclosed in Ishimaru, because upgrading client's energy-related equipment by non-polluting technology would advantageously bring health benefits to society.

Claims 4 and 26. Smith and Walker teach said method and system, wherein said collected information includes data on client geographic location (C. 14, L. 53-54); building specific factors (C. 15, L. 45-51); weather data including ambient temperature and humidity, hour of the day, type of the day and solar radiation (C. 16, L. 45-47); applicable tariffs (C. 6, L. 13); and new technology issues including micro turbines (C. 22, L. 10-22).

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Ishimaru et al. (Ishimaru) teaches an energy supply method and system for optimizing energy cost, energy consumption and emission of pollutants, comprising: collecting data on energy usage from at least one customer and energy supply data from a plurality of suppliers, and calculating and reporting costs of energy usage expected by the customer (C. 10, L. 14 – C. 11, L. 12), wherein said data on energy usage comprises data on historical or anticipated electric power usage and energy generation preferences, including solar cells, fuel cells and wind power generators (C. 9, L. 27-29; C. 10, L. 22-27).

The motivation to combine Smith and Walker with Ishimaru would be to advantageously provide the clients with various sources of energy generation equipment to choose from, thereby providing the best possible optimized solution for said energy conservation measures.

Claims 6 and 28. Ishimaru teaches an energy supply method and system, wherein the energy generation system comprises one of solar cells, fuel cells and wind power generators (C. 9, L. 27-29; C. 10, L. 22-27). The motivation to combine Smith and Walker with Ishimaru would be to advantageously provide the clients with various sources of energy generation equipment to choose from, thereby providing the best possible optimized solution for said energy conservation measures.

Claims 15 and 37. Smith teaches said method and system, including providing nationally available assistance, including support specialists on staff to monitor, record and resolve client issues (C. 13, L. 40-49).

Claims 9 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Walker further in view of Ishimaru and further in view of Ardalan et al. (US 6,396,839).

Claims 9 and 31. Smith, Walker and Ishimaru teach collecting and transmitting data on energy usage over the Internet (C. 7, L. 50-63).

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However, Smith, Walker and Ishimary do not specifically teach that collecting said data over the Internet includes collecting said data interactively from an Internet Web site.

Ardalan et al. (Ardalan) teaches a method and system for remote access to electronic meters using a TCP/IP protocol suite, wherein the data on energy usage is collected from an Internet Web site (C. 4, L. 50-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith and Walker to include that the data on energy usage is collected from an Internet Web site, as disclosed in Ardalan, because the Internet is the largest existing available network, and using the Internet would be advantageously less costly than installing the dedicated network.

Claims 17-18 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Walker further in view of Ishimaru and further in view of Achon (Building an international plastics base in Spain; April, 1996).

Claims 17 and 39. Smith, Walker and Ishimary teaches energy management method and system for developing and implementing said energy conservation measures, which include energy equipment improvement and investments; said measures are based in part on new technology issues including non-polluting issues; said implementation of said measures is based in part on current state of deregulation (See a discussion above).

However, Smith, Walker and Ishimary do not specifically teach *organizing the clients to advocate politically for regulatory changes*.

Achon teaches developing an international plastics center in Spain, wherein local producers are lobbying for reduced energy cost (regulatory changes) (Page 2; 3rd paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith, Walker and Ishimary to include lobbying for

reduced energy cost as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures.

Claims 18 and 40. Smith, Walker and Ishimary teaches energy management method and system for developing and implementing said energy conservation measures, which include energy equipment improvement and investments; said measures are based in part on new technology issues including non-polluting issues; said implementation of said measures is based in part on current state of deregulation (See a discussion above).

However, Smith, Walker and Ishimary does not specifically teach *organizing the clients to advocate politically for regulatory changes; and increasing the number of potential clients by doing so.*

Achon teaches developing an international plastics center in Spain, wherein local producers are lobbying for reduced energy cost (regulatory changes) (Page 2; 3rd paragraph).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Smith, Walker and Ishimary to include lobbying for reduced energy cost as disclosed in Achon, because it would advantageously decrease the costs of implementing said energy conservation measures.

Lobbying for reduced energy cost, disclosed in Achon, indicates influencing public opinion regarding said issues, thereby causing increase in numbers of potential clients by doing so.

Response to Arguments

Applicant's arguments filed on 04/18/2005 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art does not teach *minimally-polluting energy generation equipment*, it is noted that that Smith teaches Collecting and storing information related to energy conservation measures, said

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measures including generating a master knowledge base of *equipment* (C. 6, L. 22-23); conducting feasibility and cost-effectiveness analysis for replacing existing *equipment* (C. 14, L. 17-18); and providing a proposed solution for said measures, including: optimization of *equipment*, costs and operations of *energy systems*, and replacing *energy-related equipment* based on the collected information (C. 12, L. 42-54; C. 20, L. 59).

Furthermore, Smith teaches that said measures relate not only to equipment manufactures (C. 20, L. 59), but also the existing customer facilities equipment (C. 21, L. 32 and 42-43). As per “minimally-polluting” aspect of said equipment, Ishimaru was applied for this feature. Specifically, Ishimaru teaches collecting data on energy usage from a customer and energy supply data from suppliers while taking preservation of the environment into account (C. 10, L. 14 – C. 11, L. 12; C. 1, L. 68).

Furthermore, the Applicant admits in Applicant’s Arguments or Remarks Made in an Amendment of 04/18/2005, that “*The concepts of the invention are equally applicable to other types of equipment*” (page 11, lines 12-13). Therefore, teachings of Smith are fully applicable for applicant’s invention.

In response to the applicant’s argument that the prior art does not teach *aggregating the demand for energy generation equipment*, it is noted that Smith teaches collecting and storing information related to *energy demand* for clients (C. 7, L. 19-23; C. 9, L. 30-34); and conducting *feasibility and cost-effectiveness analysis* for replacing existing equipment (C. 14, L. 17-18).

In response to the applicant’s argument that the prior art does not teach *purchase of equipment on a bulk basis to obtain volume pricing discounts*, the examiner points out that Walker was applied for this feature. Specifically, Walker teaches a method and system for aggregating multiple buyers utilizing conditional purchase offers (CPO) for goods or services, wherein, upon accepting by a seller said aggregated CPO, binding contracts are created to binds the buyers on behalf of the accepting seller (C. 2, L. 65 – C. 3, L. 3).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Igor Borissov
Patent Examiner
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A handwritten signature in black ink, appearing to be 'Igor Borissov', written in a cursive style with a large loop at the end.

IB
7/12/2005